R E M A R K S

1. Claims 1-95 are pending in this Application. Reconsideration and further prosecution of the above-identified application are respectfully requested in view of the discussion that follows.

Claims 4-6, 8-70 and 74-95 have been rejected under 35 U.S.C. §112, first paragraph. Claims 4-6, 8-70 and 74-95 have been rejected under 35 U.S.C. §112, second paragraph. Claims 1-95 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. No. 6,263,314 to Donner. Claims 1-95 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. No. 6,393,406 to Elder. After a careful review of the claims (as amended), it has been concluded that the rejections are improper and should be withdrawn.

2. Claims 4-6, 8-70 and 74-95 have been rejected under 35 U.S.C. 112, first paragraph. In this regard, the Examiner asserts that "The applicant's specification does not disclose adequate structure for performing the recited function" (Office Actions of 10/16/04, page 2, Office Action of 7/28/04, page 3). However, "The first paragraph of §112 requires nothing more than objective enablement . . . How such a teaching is set forth, either by the use of illustrative examples or by broad terminology, is of no importance" (In re Marzocchi & Horton, 169 USPQ 367 (CCPA, 1971).

The Examiner asserts that "the applicant talks about a means for calculating from the specified security measures a security measures factor". The Examiner then asks "What is the means for doing the calculation? How is the calculation performed?" (Office Action of 10/16/04, page 2). In this regard,

"The calculation may be made using a logical and mathematical formula that may be configured into the accounting system and that the company may deem best meets its needs" (specification, page 18). FIG. 12 shows a security processor as one means for performing the calculation. Since the use of broad terminology and specifically shown structure clearly satisfies the requirements for patentability, the rejection is believed to be improper and should be withdrawn.

The Examiner asserts that "The applicant has provided no formulas with which the applicant performs the calculation. The applicant has not defined how the security measures factor is determined" (Office Action of 11/16/04, pages 2-3). In this regard, the calculation may be performed in a variety of ways based upon what the company deems best meets its needs. Since the use of broad terminology clearly satisfies the requirements for patentability, the rejection is believed to be improper and should be withdrawn.

The Examiner asserts that "The applicant talks about a threshold value in the specification and never really defines how the threshold value is determined. (Office Action of 11/16/04, page 3). As would be clearly understood by those of skill in the art, the predetermined threshold values would be chosen by the user. More specifically, "a defendable trade secret means information in which the defendability factors in combination with one or more threshold values may be used to establish that a court of competent jurisdiction would more likely than not find the existence of a trade secret" (specification, page 24). Since the use of broad terminology clearly satisfies the requirements for patentability, the rejection is believed to be improper and should be withdrawn.

The Examiner inquires "How are the values weighted?" (Office Action of 11/16/04, page 3). As would be clear to those

of skill in the art, weighting would be based upon any of a number of factors (e.g., the technology of the trade secret, knowledge of those of skill in the art, etc.). Since the use of broad terminology clearly satisfies the requirements for patentability, the rejection is believed to be improper and should be withdrawn.

The Examiner inquires "How is the net present value of a trade secret calculated?" (Office Action of 11/16/04, page 3). The net present value of a trade secret may be calculated from an estimated commercial value on a given date and an appreciation method or depreciation method using Generally Accepted Accounting Principles or other methods as described on page 32 of the specification. As would be clear to those of skill in the art, net present value would be based upon any of a number of factors (e.g., the technology of the trade secret, investment, etc.). Since the use of broad terminology clearly satisfies the requirements for patentability, the rejection is believed to be improper and should be withdrawn.

The Examiner inquires "How is the economic benefit factor calculated" (Office Action of 11/16/04, page 3). The economic benefit factor is one of the six factors entered in response to the questionnaire shown in Table C. As would be clear to those of skill in the art, calculation of economic benefit would be based upon any of a number of factors (e.g., the technology of the trade secret, financial income to the company, benefit to society etc.). Since the use of broad terminology clearly satisfies the requirements for patentability, the rejection is believed to be improper and should be withdrawn.

The Examiner inquires "How does one characterize whether the trade secret constitutes negative know-how?" (Office Action of 11/16/04, page 3). As would be clear to those of skill in the art, negative know-how is defined by knowing what does not

work. The characterization of whether the trade secret constitutes negative know-how is entered along with other data concerning the trade secret as described on page 17 of the specification. Since the use of broad terminology clearly satisfies the requirements for patentability, the rejection is believed to be improper and should be withdrawn.

The Examiner inquires "In claim 22, the applicant claims a means for calculating various weighted values of the six factors using logical and mathematical equations. The applicant has failed to provide the mathematical equations used to perform calculations" (Office Action of 11/16/04, page 3). As would be clear to those of skill in the art, weighting would be based upon any of a number of objective or subjective factors. In addition, "the assigned values may be averaged to provide the relevant metric. Alternatively, the six assigned values may be multiplied and the sixth root taken of the product" (specification, page 24). As such, the applicant has, in fact, provided mathematical equations used to perform the calculations.

The Examiner inquires "How are the security threats factors calculated" (Office Action of 11/16/04, page 3). In this regard, "Security threats may be entered as selections from a list . . . From this information the accounting system may derive a weighted security threat factor . . . The calculation may be made using a logical and mathematical formula that may be configured into the accounting system and that the company may deem best meets its needs" (specification, page 18). Since the use of broad terminology clearly satisfies the requirements for patentability, the rejection is believed to be improper and should be withdrawn.

In addition, "where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the

software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions has been disclosed" (Fonar Corporation v. General Electric Company, 107 F.3d 1534, 41 U.S.P.Q. 2d 1801 (Fed. Cir. 1997)). Since the functions of claims 4-6, 8-70 and 74-95 would be clearly understood by a person of average skill in the art from the description, there cannot be any doubt that the described functions enable the claiming of the processes of those functions.

In addition, since the described functions are enabling, the structures (i.e., the processing software) that performs those functions are also enabling. As explicitly set forth in the specification, "In this document, 'processor' means a device capable of performing the steps of the specific process under discussion" (specification, page 13). As such, the claimed method steps, means and apparatus for performing those functions are clearly enabled.

It should be noted that the Examiner's statement that "The applicant's specification does not disclose adequate structure for performing the recited function" (Office Action of 11/16/04) is not supported by Fonar. As may also noted, the above discussion of Fonar is at odds with the Examiner's rejections.

3. Claims 4-6, 8-70 and 74-95 have been rejected under 35 U.S.C. 112, second paragraph. The Examiner queries "how is the indexing performed" (Office Action of 11/16/04, page 3). In this regard, the process of indexing is described in numerous places within the specification (e.g., page 16, 17, etc.). As such, the process of indexing is objectively enabled by the specification. Since the specification clearly enables indexing, any claim that is commensurate in scope with the specification would be

understood to meet the requirements of 35 U.S.C. §112, second paragraph. Since the claims related to indexing are clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "how are trade secret drafts converted into trade secret application" (Office Action of 11/16/04, page 3). In this regard, the process of converting trade secret drafts is described in general within the specification (e.g., page 35). As such, the process of converting trade secret drafts is objectively enabled as required by 35 U.S.C. §112, second paragraph. Since the claims related to conversion clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "How are the security measure specified" (Office Action of 11/16/04, page 3). In this regard, security measures are described in general within the specification (e.g., page 3). As such, the process specifying security measures is objectively enabled as required by 35 U.S.C. §112, second paragraph. Since the claims related to security measures clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "How are security threats specified" (Office Action of 11/16/04, page 3). In this regard, the process of dealing with security threats is described in general in numerous locations within the specification (e.g., pages 6, 16-19, etc.). As such, the process of dealing with security threats is objectively enabled as required by 35 U.S.C. §112, second paragraph. Since the claims related to security threats clearly meet the requirements of 35 U.S.C. §112, second

paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "What are the six factors of a trade secret as enumerated in Section 757 of the First Restatement of Torts" (Office Action of 11/16/04, page 3). In this regard, the six factors of a trade secret (as enumerated in Section 757 of the First Restatement of Torts) are discussed in general in numerous locations within the specification (e.g., page 3, 20, 23, 32, etc.). In addition, the six factors are specifically called out in Table C beginning on page 20 of the specification. As such, the six factors of a trade secret as enumerated in Section 757 of the First Restatement of Torts are objectively enabled by the specification. In addition, the six factors have now been made an explicit element of the independent claims. Since the specification clearly enables the six factors of a trade secret as enumerated in Section 757 of the First Restatement of Torts, any claim that is commensurate in scope with the specification would be understood to meet the requirements of 35 U.S.C. §112, second paragraph. Since the claims related to the six factors clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "How are the values weighted" (Office Action of 11/16/04, page 3). In this regard, the weighting of the six factors is discussed in general in numerous locations within the specification (e.g., page 5, 8, 20, etc.). As such, the weighting of the six factors of a trade secret as enumerated in Section 757 of the First Restatement of Torts is objectively enabled by the specification. Since the specification clearly enables the weighting, any claim that is commensurate in scope with the specification would be understood to meet the requirements of 35 U.S.C. §112, second paragraph.

Since the claims related to weighting clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "What is a combinational trade secret" (Office Action of 11/16/04, page 3). In this regard, combinational trade secrets are discussed in general within the specification (e.g., page 17). As such, combinational trade secrets are objectively enabled as required by 35 U.S.C. §112, second paragraph. Since the claims related to combinational trade secrets clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "What constitutes negative know-how" (Office Action of 11/16/04, page 4). In this regard, negative know-how is discussed in general in numerous locations within the specification (e.g., pages 4, 17, etc.). As such, the concept of negative know-how is objectively enabled as required by 35 U.S.C. §112, second paragraph. Since the claims related to negative know-how clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

The Examiner queries next "How does one create a specification of the type trade secret using alphabetic, numeric, or alphanumeric codes" (Office Action of 11/16/04, page 4). In this regard, the use of alphabet, numeric, or alphanumeric codes for specifying trade secrets is discussed in general in numerous locations within the specification (e.g., page 16, 30-34, etc.). As such, the typing of trade secrets by alphabetic, numeric, or alphanumeric codes is objectively enabled by the specification. Since the specification clearly enables the typing of trade secrets by alphabetic, numeric, or alphanumeric codes, any claim that is commensurate in scope with the specification would be

understood to meet the requirements of 35 U.S.C. §112, second paragraph. Since the claims related to typing trade secrets clearly meet the requirements of 35 U.S.C. §112, second paragraph, the rejections are believed to be improper and should be withdrawn.

Further, "As a matter of Patent Office Practice, then, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of § 112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied upon for enabling support" (In re Marzocchi & Horton, 169 USPQ 367 (CCPA, 1971). In general, the subject matter sought to be patented is defined by the claims. Since the claimed subject matter corresponds in scope to the teaching of the specification, the Examiner is obligated to provide a basis for doubting the truth of the teachings. More importantly, "it is incumbent upon the Patent Office, whenever a rejection is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertion of its own with acceptable evidence or reasons which is inconsistent with the contested statement" (In re Marzocchi). Since the Examiner has failed to provide a basis for doubting the objective truth of the specification, the rejections are clearly improper and should be withdrawn.

6. Claims 1-95 have been rejected as being anticipated by Donner. In response, independent claim 1 has been limited to "A programmed computer based upon the six factors of a trade secret

from the First Restatement of Torts for identifying trade secrets within a plurality of potential trade secrets of a business". Support for the programmable computer may be found throughout the specification (e.g., page 11, FIG. 1, etc.). The use of the programs within the programmed computer is also discussed at numerous places within the specification (e.g., page 12, page 18, etc.).

Independent claim 1 has also be further limited to "means within the programmed computer for providing a predetermined criteria for evaluating a potential trade secret of the plurality of potential trade secrets under each of the six factors of a trade secret from the First Restatement of Torts, said six factors including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees and others involved in the business; (3) the extent of measures taken by the business to guard the secrecy of the information; (4) the value of the information to the business and its competitors; (5) the amount of time, effort or money expended by the business in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others". One example of the predetermined criteria for each of the six factors may be found within Table C. The six factors of the First Restatement of Torts is also shown in Table C. The specification discusses "At least one means for storing the data entered into the system, as well as the programs required to implement the system" (specification, page 12). FIG. 1 of the specification shows a user interface device and a mass data storage device.

Independent claims 1 has been limited to "means within the programmed computer for receiving a numerical score value for the potential trade secret under the predetermined criteria for

each of the six factors". FIG. 1 of the specification shows a user interface device and a mass data storage device.

Independent claims 1 has been limited to "means within the programmed computer for calculating a metric from the received numerical score values under the six factors". The specification discusses (page 24) the process of calculating the metric. FIG. 12 shows an arithmetic processor.

Independent claim 1 has been limited to "means within the programmed computer for ranking the potential trade secret with regard to another potential trade secret found among the plurality of potential trade secrets based upon the calculated metric". Support for the step of ranking potential trade secrets may be found in line 23 of page 71 of the specification, as originally filed. In addition, "In this document, 'processor' means a device capable of performing the steps of the specific process under discussion" (specification, page 39, lines 9-10).

In contrast, Donner is limited to patents that are found within an existing intellectual property portfolio. In addition, Donner is directed to placing a value on patents rather than to any process for accounting for trade secrets.

Since Donner is limited to placing a value on an existing portfolio of patents, Donner would have no reason to provide the method steps of (or apparatus for) "the programmed computer providing a predetermined criteria for evaluating a potential trade secret of the plurality of potential trade secrets under each of the six factors of a trade secret from the First Restatement of Torts, said six factors including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees and others involved in the business; (3) the extent of measures taken by the business to guard the secrecy of the information; (4) the value of the information to the business and its competitors; (5) the amount

of time, effort or money expended by the business in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others", "the programmed computer receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors", "the programmed computer calculating a metric from the received numerical score values under the six factors", "the programmed computer determining that the potential trade secret is a trade secret when the calculated metric exceeds a predetermined threshold value" or "ranking the potential trade secret with regard to another potential trade secret found among the plurality of potential trade secrets based upon the calculated metric".

Since Donner is limited to placing a value on an existing portfolio of patents, Donner does not do the same or any similar thing in the same way as that of the claimed invention. Since Donner does not do the same or any similar thing, the rejections are believed to be improper and should be withdrawn.

7. Claims 1-95 have been rejected as being anticipated by Elder. In response, independent claims 1 has been further limited as described above in the discussion of Donner.

In contrast, Elder fails to provide any teaching or suggestion of a "the programmed computer providing a predetermined criteria for evaluating a potential trade secret of the plurality of potential trade secrets under each of the six factors of a trade secret from the First Restatement of Torts, said six factors including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees and others involved in the business; (3) the extent of measures taken by the business to guard the secrecy of the information; (4) the value of the

information to the business and its competitors; (5) the amount of time, effort or money expended by the business in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others", "the programmed computer receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors", "the programmed computer calculating a metric from the received numerical score values under the six factors", "the programmed computer determining that the potential trade secret is a trade secret when the calculated metric exceeds a predetermined threshold value" or "ranking the potential trade secret with regard to another potential trade secret found among the plurality of potential trade secrets based upon the calculated metric".

The Examiner asserts that "The language directed to an intended use of the system in a claim for an apparatus or system does not result in a structural or functional difference with respect to the prior art" (Office Action of 7/28/04, page 6). However, the claimed "providing a predetermined criteria . . . receiving a numerical score value . . . calculating a metric . . . determining that the potential trade secret is a trade secret" or "ranking the potential trade secret" is not directed to an intended use of the trade secret accounting system; but, instead, is a description of the structural and functional features of the data processing means that differentiates the claimed programmed computer from the data processing means of Elder.

Since Elder clearly fails to teach or suggest any of these features, Elder clearly does not do the same or any similar thing in the same way as that of the claimed invention. Since Elder fails to teach the same or any similar thing, the rejections are believed to be improper and should be withdrawn.

8. New method claims 119, 120 and 121 have been added to the application. Support for the elements of claims 119 and 120 are provided within the specification, as noted in the discussion of Donner with regard to the changes to claims 1 and 71.

9. The allowance of claims 1-95 and 119, 120 and 121 as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

Respectfully submitted,

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